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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,433	09/05/2003	Cong Thanh Dinh	577-599 (T&B 1733)	4759
23869	7590	10/19/2005		
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			EXAMINER LHYMN, EUGENE	
			ART UNIT 3727	PAPER NUMBER
DATE MAILED: 10/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/656,433

Applicant(s)

DINH, CONG THANH

Examiner

Eugene Lhymn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/5/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/5/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 11-20 have been renumbered 10-19.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 13 recites the limitation "said collar." There is insufficient antecedent basis for this limitation in the claim. Moreover, claim 19 recites the limitation "said rim." There is also insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 14 & 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Peevey (US 2378861). With respect to claim 14, Peevey discloses the following:

- A box including a back wall bounded by a top and bottom wall, and a pair of opposed sidewalls, as shown in Fig. 1, wherein the sidewalls are the longitudinally longer walls
- A frame telescopically received in the box opening (Fig. 1, item 11)
- An adjustment device including at least one threaded member rotatably secured to the frame and threadedly received in of the sidewalls of the box (Fig. 4)

With respect to claim 18, Peevey discloses the adjustment device retaining the frame to the box, as shown in Fig. 4.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 9, 11-12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peevey (US 2378861) in view of McAfee (US 2989206). With respect to claim 1, Peevey discloses the following:

- A box including a back wall bounded by a top and bottom wall, and a pair of opposed sidewalls, as shown in Fig. 1, wherein the sidewalls are the longitudinally longer walls
- A frame telescopically received in the box opening (Fig. 1, item 11)
- An adjustment device rotatably secured to the frame and engagable with the perimeter wall of the box, whereby causing relative movement between the box and frame, as shown in Fig. 1, item 13

However, Peevey fails to teach a bracket fixedly secured to the perimeter wall and extending outwardly therefrom. Nonetheless, McAfee teaches an outlet box extension having a bracket fixedly secured to the perimeter wall and extending outwardly therefrom, as shown in Fig. 1, item 12. Having a bracket attached to the perimeter wall provides a convenient means for securing the junction box to an adjacent surface, such as a wall. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add a bracket to the box perimeter wall of Peevey as taught by McAfee so as to provide a convenient means for securing the junction box to an adjacent surface, such as a wall.

With respect to claim 2, Peevey teaches the adjustment member including a member rotatably secured to the frame (Fig. 4)

With respect to claim 3, Peevey teaches the member being threaded and threadedly secured to the perimeter wall (Fig. 4)

With respect to claim 4, Peevey teaches one of the box sidewalls including a threaded opening (Fig. 4, item 10 & Page 1, Col. 2, Lines 27-31).

With respect to claim 5, Peevey teaches the threaded opening being integrally formed on one of the box sidewalls (Fig. 1, item 10).

With respect to claim 6, Peevey teaches the adjustment device being disposed at a point between the top and bottom wall of the box (Fig. 1).

With respect to claim 9, McAfee teaches the frame being adapted to be secured to an electrical component (Col. 2, Lines 53-56).

With respect to claim 11, Peevey teaches the adjustment device including only one threaded member, as shown in Fig. 1, item 13. Although Peevey teaches the use of two adjustment devices and claim 11 is phrased with closed language, i.e. - includes only, independent claim 1 uses the open language of "comprising" whereby all subsequent dependent claims will be interpreted as "comprising" thereafter.

With respect to claim 12, McAfee teaches the frame including a pair of opposed securement points (Page 1, Col. 2, Lines 27-31).

With respect to claim 17, McAfee teaches the frame including an electrical component attachment point (Col. 2, Lines 53-56).

7. Claims 7-8, 10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peevey in view of McAfee as applied to claim 1 above, and further in view of Kleinatland et al. (US 4134636). With respect to claim 7, Peevey, as modified above, discloses the claimed invention except for the frame and box including a

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cooperating groove and projection arrangement. However, Kleinatland et al. teaches a junction box wherein the frame and box include a cooperating groove and projection arrangement, as shown in Fig. 1. Having a groove and projection arrangement between the box and frame provides a convenient and effective means of movement between the box and frame. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add a projection and groove interface between the box and frame of Peevey as taught by Kleinatland et al. so as to provide a convenient and effective means of movement between the box and frame.

With respect to claim 8, Kleinatland teaches a bottom wall of the box including a projection and a corresponding portion of the frame including a groove. Although the foregoing is the direct opposite of the limitation recited in claim 8, it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

With respect to claim 10, Kleinatland teaches the frame (Fig. 1, item 26) including a sidewall having a collar ending in a rim, and the collar extending outwardly beyond the sidewall (Fig. 1, item 28).

With respect to claim 13, Kleinatland teaches the box having walls that end in an edge, wherein the edge supports the frame collar when the frame is in a fully retracted state, as shown in Fig. 1.

8. Claims 15-16 & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peevey in view of Kleinatland et al. With respect to claim 15, Peevey discloses the

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claimed invention except for the frame except for the frame and box including a cooperating groove and projection arrangement. However, Kleinatland et al. teaches a junction box wherein the frame and box include a cooperating groove and projection arrangement, as shown in Fig. 1. Having a groove and projection arrangement between the box and frame provides a convenient and effective means of movement between the box and frame. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add a projection and groove interface between the box and frame of Peevey as taught by Kleinatland et al. so as to provide a convenient and effective means of movement between the box and frame.

With respect to claim 16, Kleinatland teaches a bottom wall of the box including a projection and a corresponding portion of the frame including a groove. Although the foregoing is the direct opposite of the limitation recited in claim 8, it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

With respect to claim 19, Peevey teaches the threaded member including a top portion disposed adjacent the rim.

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Turan (US 5975323)

Smolik (US 4599485)



Shotey (US 5171939)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Lhymn whose telephone number is 571-272-8712. The examiner can normally be reached on MTWTh 8:30-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571)272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**NATHAN J. NEWHOUSE**  
**SUPERVISORY PATENT EXAMINER**